

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TADAO TAKIZAWA

Appeal No. 96-0141
Application No. 08/084,097¹

ON BRIEF

Before GARRIS, OWENS, and WALTZ, Administrative Patent Judges.
WALTZ, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 5 through 10. Claims 1 through 4, the only other claims in this application, stand

¹ Application for patent filed July 1, 1993.

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withdrawn from consideration by the examiner as being drawn to a nonelected invention (Brief, page 1).

According to appellant, the invention is directed to a method of manufacturing an integrally molded pointer by a process comprising a sequential series of specific manipulative steps (Brief, page 2). Claim 5 is illustrative of the subject matter on appeal and is reproduced below:

5. A process of manufacturing a pointer by molding a resin in a mold comprising an upper die having a plurality of cavities and a lower core die comprising forming a first molding space with said core die and a first cavity corresponding to a weight section of said pointer, injecting a mixture of resin material and metal powder into said first molding space, forming a second molding space with said core containing said weight section and a second cavity, and injecting the resin material into the second molding space corresponding to an indicating section of said pointer thereby integrally molding said weight section and said indicating section of said pointer.

The examiner has relied upon the following references as evidence of obviousness, in addition to the admitted prior art cited by appellant on page 3 of the specification:

Linne	4,269,802	May 26, 1981
Patel	4,885,121	Dec. 5, 1989
Hirota et al. (Hirota)	5,167,896	Dec. 1, 1992
Pasco	0 411 799 A1	Feb. 6, 1991
(Published European Patent Application)		

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Claims 5 through 7 stand rejected under 35 U.S.C. § 103 as unpatentable over Linne in view of Pasco, "the admitted prior art as discussed on page 3 of the instant specification", and Hirota (Answer, page 3). Claims 8 through 10 stand rejected under 35 U.S.C. § 103 as unpatentable over the references applied against claims 5 through 7 further in view of Patel (Answer, page 5). We reverse both of the examiner's rejections for reasons which follow.

OPINION

Conventional manufacturing techniques in this particular art comprise the installation of an independent balance weight separately from the pointer body after completion of the pointer (Brief, page 2; specification, page 3, last paragraph; and Pasco, column 1, line 42-column 2, line 2; column 3, lines 11-14).

The process of manufacture recited in appealed claim 5 comprises integrally molding the pointer body with the balance weight section comprising resin and metal powder, thereby making it unnecessary to install and fix the balance weight

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separately from the pointer body (Brief, page 3;
specification, page 5).

The examiner applies the Linne reference to show the conventionality of using a set of molding dies to create multiple molding spaces, the Pasco reference and the admitted prior art to show conventional pointers made from injection molding and from two different resins, the admitted prior art for the teaching of mixing metal powder and resin for molding weights for a pointer, and Hirota for a multilayered article made from a layer of resin and a layer of reinforced resin (Answer, pages 3-4). From these teachings, the Examiner concludes that it would have been obvious to the artisan "to use the above process as set forth in the primary reference for making any number of composite articles using two different resins" (Answer, page 4).

"When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references. [Citation omitted]." *In re Rouffet*, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). When determining the patentability of a claimed

invention which combines numerous elements, "the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. [Citations omitted]." *In re Rouffet*, 149 F.3d at 1356, 47 USPQ2d at 1456. We do not find, on this record, that the examiner has shown that the prior art, as a whole, would have suggested the desirability of making the combination claimed by appellant. The examiner has not shown on this record why one of ordinary skill in the pointer art would have combined the molding process for making a unitary seal disclosed by Linne with the conventional methods of making pointers taught by Pasco and the admitted prior art while adding the reinforced sandwiched structure of a display cabinet of Hirota.

It is noted that evidence of a suggestion, teaching or motivation to combine may come from the prior art references themselves, the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved. See *Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996). In our view, the

examiner has not particularly identified any suggestion, teaching or motivation to combine the applied references in the manner proposed (see the Answer, pages 8-9). The examiner has not identified any disclosure or suggestion in the applied prior art which is directed to composite pointers,² much less composite pointers needing adhesives (Linne teaches avoiding the use of adhesives by integral molding, see the Answer, sentence bridging pages 8-9).

The process of making a pointer as set forth in appealed claim 5 would not have been *prima facie* obvious even if the applied prior art was combined in the manner proposed by the examiner. The examiner does not identify any reference which discloses or suggests the use of metal powder and resin in only a *part* of any pointer, much less an integral pointer, to act as a balancing weight (see the specification, page 3, Examined Japanese Utility Model Laid-Open No. SHO 60-143,366). Furthermore, the examiner's assumption that metal powder can

²The examiner generally refers to "composite pointers" in relation to Pasco (Answer, pages 3 and 4) but Pasco merely forms a pointer by molding with subsequent insertion of a weight or "mass" or molds the pointer "around" the weight or "mass" as it is held in place (Pasco, column 3, lines 11-14).

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be used in place of the fiber reinforcing material of Hirota is not supported by any evidence (see the Answer, page 4, last paragraph).

Patel is applied by the examiner to show the conventionality of rotating core dies (Answer, page 5). We find that Patel does not remedy any of the deficiencies of the examiner's rejection noted above.

For the foregoing reasons, we determine that the examiner has not presented a *prima facie* case of obviousness in view of the applied prior art. Accordingly, the rejection of claims 5-7 under 35 U.S.C. § 103 as unpatentable over Linne in view of Pasco, the admitted prior art on page 3 of the specification, and Hirato is reversed.

The rejection of claims 8-10 under § 103 over the same references further in view of Patel is also reversed.

The decision of the examiner is reversed.

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REVERSED

BRADLEY R. GARRIS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
TERRY J. OWENS)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
THOMAS A. WALTZ)	
Administrative Patent Judge)	

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APJ WALTZ

APJ GARRIS

APJ OWENS

DECISION: REVERSED

Send Reference(s): Yes No
or Translation (s)

Panel Change: Yes No

Index Sheet-2901 Rejection(s): _____

Prepared: January 30, 2001

Draft Final

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OB/HD GAU

PALM / ACTS 2 / BOOK
DISK (FOIA) / REPORT